

DOCKET NO.: 264731US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
STEPHAN HUEFFER, ET AL. : EXAMINER: KHAN, AMINA
SERIAL NO.: 10/524,047 :
FILED: OCTOBER 13, 2005 : GROUP ART UNIT: 1796
FOR: FORMULATION FOR USE IN :
CHROME-FREE AND CHROME
TANNING

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Examiner's Answer dated April 21, 2008, please consider the following remarks.

In the Examiner's Answer, the Examiner asserts that the primary references (Komforth, Plapper) disclose tanning, fatliquoring and retanning methods in which compositions including kaolin and bentonite are employed. It is undisputed that neither of the primary references discloses a tanning method employing a clay mineral having the particle size required by claim 32. The Examiner relies on the secondary references (Cramer, Zorn, Christner) for their alleged disclosure of clay minerals having particle sizes as required by claim 32. However, the clay minerals of the secondary references are used in compositions employed for wholly different purposes than the clay minerals are employed in the compositions of the primary references. That is, the clay minerals of the secondary references are not used in tanning, fatliquoring and retanning methods. Nor is there anything

in any of the secondary references suggesting that the clay minerals of the secondary references would be particularly useful or more useful than the clay minerals of the primary references in tanning, fatliquoring and retanning methods. While the Examiner points to explanations in the secondary references of the benefits of the employed clay minerals in the disclosed applications, the Examiner provides no explanation of why these benefits would have any applicability to the tanning, fatliquoring and retanning methods of the primary references. The mere fact that particular clay minerals would be useful in one context provides no guidance with respect to their usefulness in another, different context. As discussed previously, there must be some apparent reason to combine the respective teachings of cited references. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007).

In the Examiner's Answer, the Examiner asserts that the experimental results included in the present specification and relied in the March 18, 2008 Appeal Brief are not commensurate in scope with the present claims. Appellants note that the results in the present specification have been discussed at length during prosecution of this application prior to appeal, and the Examiner has only now asserted that the results are not commensurate in scope with the claims (at a procedural moment where Appellants cannot, e.g., submit additional evidence, without terminating the appeal). Moreover, the Examiner has provided no basis for this conclusion. The Examples of the present specification include four exemplary clay minerals falling within the scope of claim 32 having a variety of different particle sizes and four exemplary clay minerals falling outside of the scope of claim 32 having a variety of different particle sizes. The Examples of the present specification include sufficient data so that one of ordinary skill in the art could reasonably extend the probative value of the data to the full scope of claim 32. *See, e.g.,* MPEP §716.02(d). Moreover, among the Comparative Examples are clay minerals having particle sizes corresponding to

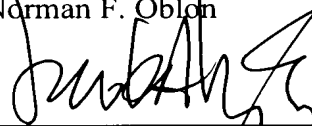
the particles sizes used in the primary reference, Plapper, the apparent closest prior art. *See, e.g.,* MPEP §716.02(e). Appellants submit that the results in the present specification demonstrate that the method of claim 32 provides an unexpected, superior result in comparison with known methods, and such results rebut any alleged *prima facie* case of obviousness. Appellants request that the evidence in the present specification be given its due weight, which has not yet occurred during the course of prosecution of this application.

For the foregoing reasons, as well as the reasons set forth in the March 18, 2008 Appeal Brief, Appellants request that all outstanding rejections of the pending claims be REVERSED.

Respectfully submitted,

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